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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,589	04/30/2001	Dale F. McIntyre	82466RLO	2441

7590

04/21/2005

Thomas H. Close
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

CARTER, MONICA SMITH

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/845,589
Filing Date: April 30, 2001
Appellant(s): MCINTYRE ET AL.

MAILED

APR 21 2005

Group 3700

J. Randall Beckers
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 21, 2005.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 20-27 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

5,712,005	MONN	1-1998
6,324,545	MORAG	11-2001

<http://film.jcpenneyportraits.com> (February 7, 2001)

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over <http://film.jcpenneyportraits.com> (hereafter referred to as FJCP) in view of Monn (5,712,005).

FJCP discloses a method of arranging a series of at least two visual images of different characteristics of the same image comprising using a photographic digital image to produce a series of digital images of the same image where the images have different characteristics as specified by the user; the images are formed on a single photographic print medium and can be manually cut out from the medium. FJCP further discloses the ability to provide the print mediums with indicia (i.e., "Happy Easter", "Please Come", "You're Invited", etc.). Inherently, this would include providing instructions on the print medium since it would only depend on the intended use of the assembly and the desired information to be displayed. It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate

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may render the device more convenient by providing an individual with a specific type of print medium does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

FJCP discloses the claimed invention except for explicitly disclosing manually fixing the cut out visual images on a page to form a composite image which can be used in a scrapbook. It is well-known in the art to cut out digital images for scrapbooking purposes. Monn discloses a kit for decorating a photo album storage box wherein the edges of a photocopy of a photograph are torn according to an enclosed instruction sheet (20) (as seen in figures 1 and 2). Adhesive is then applied to the back side of the photocopy such that the photocopy can be applied to box to provide a collage of torn photocopies (see col. 4, lines 18-52). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the images of the print medium of FJCP to be cut out and fixed to a surface in a scrapbook, as taught by Monn, to provide the images in a book in a manner which is aesthetically pleasing to the user.

Regarding claim 3, FJCP, as modified by Monn, discloses the characteristics including different sizes.

Regarding claim 4, see the above rejections to claim 1.

Regarding claim 6, FJCP, as modified by Monn, discloses the cut out images being fixed by using an adhesive as set forth above.

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Regarding claim 8, FJCP, as modified by Monn, discloses the method of making a scrapbook page as set forth in the rejections to claim 1. Further, FJCP, as modified by Monn, discloses providing a collection of pictures to create a collage (this would provide a page annotated with other pictures).

Regarding claims 10 and 11, see the above rejections to claim 1.

Regarding claim 12, FJCP, as modified by Monn, discloses the visual images being photographic images.

Regarding claim 13, FJCP, as modified by Monn, discloses the characteristics including different sizes.

Regarding claim 14, FJCP, as modified by Monn, discloses providing other visual images after fixing the visual image (see Monn, col. 4, lines 38-52).

Regarding claim 15, see the above rejections to claim 1.

Regarding claim 17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and

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unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claim 18 and 23-25, see the above rejections to claim 1.

Regarding claim 26, see the above rejections to claim 1.

Regarding claim 27, see the above rejections to claim 1.

2. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over FJCP in view of Monn, as used above, and further in view of Morag ('545).

FJCP, as modified by Monn, discloses the claimed invention except for sending a digital image over a communication channel to a service provider with instructions to the service provider.

Morag discloses a method of generating a personalized photo album comprising using digital images transmitted over a service provider. The images and instructions are transmitted by digital means such as over the Internet. The service provider prints the images on a single sheet of paper. Once the album is complete, an electronic proof copy may be sent to the customer for approval having computer-readable instructions for viewing and/or printing of the album. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify FJCP's invention to include instructions, as taught by Morag, for providing information related to the album between the customer and the service provider.

(11) Response to Argument

Prima Facie Case Not Made

Appellant argues that the Examiner has not made out a prima facie case of obviousness of claims 1, 3, 4, 6, 8, 10-15, 18 and 23-27 over FJCP and Monn. Appellant argues that the FJCP reference fails to disclose providing instructions concerning how to create or what to do with the sheets of photographs, the greeting card photo, the greeting card stock or how to select a greeting for the greeting card. Appellant further argues that Monn fails to make up the deficiencies of FJCP, since Monn discloses instructions for a box decoration. Appellant argues that one would have to turn to a hypothetical common understanding to fill in the gaps and that there is no evidence of the common understanding before the Board.

The Examiner disagrees and maintains that FJCP discloses a method of arranging a series of at least two visual images of the different characteristics of the same image using a photographic digital image where the image have different characteristics as specified by the user. The images are formed on a single photographic print medium and can be manually cut out from the medium, which is commonly done so that the pictures can be distributed among family members, friends, etc. FJCP further discloses that it is well-known to provide the print medium with indicia (i.e., "Happy Easter") incorporated on the print medium adjacent the digital image. The process of personalizing print medium is a well-known practice. For example, during the holiday season, families take pictures to be dispersed to family and friends. Commonly, the print medium containing the pictures is personalized with the surname of the family ("The Smiths 2005"). It has been held that when the claimed printed matter is not

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functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). In the appealed application, the claimed indicia comprises printed matter that has been printed onto a substrate where the printed matter does not convey any meaningful information in regard to the substrate and does not require any particular substrate to effectively convey the information. Thus, there is no meaningful functional relationship between the indicia and the substrate.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter. Therefore, it would have been obvious to provide the print medium with instructions for making the scrapbook on the single photographic print medium to display the desired information

Furthermore, Monn discloses providing instructions on a sheet in a memory box for storing photos. The printed instructions are provided to the user with the proper steps to construct a photo album.

FJCP discloses the claimed invention except for explicitly disclosing manually fixing the cut out images on a page to form a composite image to be used in a scrapbook. The process of cutting out the digital images is a well-known process so that the pictures may be distributed among family members and friends. Further, Monn discloses cutting photographs and applying them to a box to provide a collage of torn photocopies (as seen in column 4, lines 18-52).

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For the reasons as set forth above, the examiner maintains that a prima facie case of obviousness of claims 1, 3, 4, 6, 8, 10-15, 18 and 23-27 has been established.

Appellant argues that the Examiner has not made out a prima facie case of obviousness of claims 20-22 over FJCP, Monn and Morag. Appellant argues that Morag adds nothing to the disclosure of FJCP and Monn with respect to forming images of different characteristics and instructions for making a scrap book page on the same medium and making the page via a composite image.

The Examiner maintains the same line of reasoning with respect to the FJCP and Monn references. It is noted that Morag has been solely used for disclosing sending a digital image over a communication channel to a service provider with instructions to the service provider and has not been relied upon for disclosing any of the other claimed limitations.

Morag discloses a method of generating a personalized photo album comprising using digital images transmitted over a service provider. The images and instructions are transmitted by digital means such as over the Internet. The service provider prints the images on a single sheet of paper. Once the album is complete, an electronic proof copy may be sent to the customer for approval having computer-readable instructions for viewing and/or printing of the album. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify FJCP's invention to include instructions, as taught by Morag, for providing information related to the album between the customer and the service provider.

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Appellant argues that Morag fails to disclose providing instructions to the service provider that instruct the production of “a series of digital images of the same image where each of the digital images of the same image have different characteristics.”

The Examiner asserts that even though the content of instructions as claimed differs from instructions in prior art, the addition of new set of instructions into a known process merely teaches a new use for an existing process, in that the instructions do not interrelate with the method of arranging the images usable in a scrapbook so as to produce a new process. Furthermore, Morag discloses instructions for arranging the images on each page of the album and that changes in the formatting instructions may be made to include any desired instructions (see column 6, lines 61-64, column 8, lines 55-67 through column 9, lines 1-22 and column 10, lines 23-28).

Appellant argues that Morag fails to disclose making payment via the channel to the service provider.

The examiner disagrees and asserts that Morag inherently discloses that a payment is made via the channel to the service provider, since Morag discloses a “customer” transmitting images to the service provider to ultimately receive an assembled photo album. A “customer” is referred to one that buys goods or services and, therefore, payment would be made to the service provider for assembling the photo album.

Appellant argues that Morag fails to disclose the channel being a local channel or the Internet.

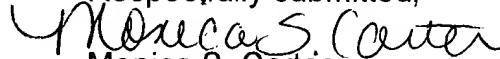
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The examiner disagrees. As stated in the Final Office action, Morag discloses images and instructions being transmitted by digital means such as over the Internet (see column 3, lines 41-47).

For the reasons as set forth above, the examiner maintains that a prima facie case of obviousness of claims 20-22 has been established.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Monica S. Carter

Primary Examiner

Art Unit 3722

April 18, 2005

Conferees



Derris Banks

Supervisory Patent Examiner

Art Unit 3722



Gregory Vidovich

Supervisory Patent Examiner

Art Unit 3711

THOMAS H. CLOSE
PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201